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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,118	10/06/2003	Lee Salzmann	4593-4000	1066
7590		12/18/2007		
Tony A. Gayoso				
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			EXAMINER	
			AUGUSTIN, EVENS J	
			ART UNIT	PAPER NUMBER
			3621	
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			12/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/678,118

**Applicant(s)**

SALZMANN ET AL.

**Examiner**

Evans Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/07/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgement***

1. This is in response to an amendment filed on August 7th, 2007. Claims 26-103 are pending.

### ***Response to Arguments***

2. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on August 7th, 2007, but has not found those arguments to be persuasive.

**Argument 1:** Motivations that arise from the inventor's disclosure or later acknowledgement of others cannot be used in a rejection. Since the rejection does not cite anywhere in the prior art where such motivation comes from, it must be presumed that the alleged motivation comes from somewhere other than the prior art and use of that motivation is improper and prejudicial.

**Response 1:** According to the MPEP 2145, section IX, A, "there is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness." See Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). For example, motivation to combine prior art references may exist in the nature of the problem to be solved (Ruiz at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (National Steel Car v. Canadian Pacific Railway Ltd., 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004))". Accordingly, the office action states that it would have been to one of ordinary skill in the art at the time the invention was made to modify the MacDonald et al's inventive concept to include Messing's invention of receiving an electronic

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signature indicating approval of the preliminarily compiled at least one form electronic document because this would have created a more agile system.

With regard to the signature and approval, the PTO contends that the act of signing one's name to something is inherently giving approval to that something on which the name is signed. Additionally, the art is littered with references that are may teach applicant's present invention.

The USPTO would highly suggest applicant to look into the following application, as they are similar to the claimed invention.

**Raveis (US 6321202)** - The subject invention relates to managing real estate transactions, and more particularly, to a system and method for gathering, processing, disseminating and controlling information relating to real estate transactions

**Broerman (US 6594633)** - The invention is generally related to computers and computer software, and to the provision of real estate brokerage and associated services to users coupled to an electronic communications medium.

**Mini et al. (US 6684196)** - The present invention relates to facilitating transactions between remote parties via a network. More specifically, the present invention provides methods and apparatus for facilitating real estate transactions from beginning to end via the Internet.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 26-103 rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald et al (U.S. PG Pub No. 2004/0019558) in view of Messing (U.S. Patent No 7,039,805).

3. As per claims 26, 31-34, MacDonald et al teach a method of using a computer system to facilitate a real estate transaction comprising receiving real estate transaction information for the real estate transaction (such as sale of property, estate financing, insuring property, sale of mortgage), outputting a preliminarily compiled at least one form electronic document to be used in the real estate transaction, wherein the form is compiled with at least some of the real estate transaction information; receiving a digitally scanned image of at least one ancillary document, and outputting the at least one ancillary document in conjunction with a finally compiled said preliminary compiled at least one form electronic document integrating a signature into said preliminary compiled at least one form electronic document (*see figs 3, paragraphs 0015, 0031, 0032, 0033, 0073, 0091-0271*). MacDonald et al fail to teach receiving an electronic signature indicating approval of the preliminarily compiled at least one form electronic document.

However, Messing teaches receiving an electronic signature indicating approval of the preliminarily compiled at least one form electronic document (*see column 2 lines 5-35, 3 line 55-4 line 26*). Therefore, it would have been to one of ordinary skill in the art at the time the invention was made to modify the MacDonald et al's inventive concept to include Messing's invention of receiving an electronic signature indicating approval of the preliminarily compiled at least one form electronic document because this would have created a more agile system.

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4. As per claims 27-30 and 35-41, MacDonald et al teach a method wherein the real estate transaction information is party information identifying a party (buyer, a seller, a borrower, a lender, a mortgage investor) and (the property, financial information such as loan) related to the real estate transaction and wherein the signature integrated into the finally compiled at least one form document is a handwritten signature (*see figs 3, paragraphs 0015, 0031, 0032, 0033, 0073, 0091-0271*).

5. As per claims 42-103, the disclosed the same inventive concept as claims 26-41 and their limitations are fully taught in MacDonald disclosure. Therefore, they are rejected under the same rationale.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
4. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/  
Evens J. Augustin  
October 7, 2007  
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